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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,899	01/08/2002	Joe Freeman Britt JR.	04676.P020	5830
7590 01/02/2009 Thomas C. Webster BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026				
EXAMINER STERRETT, JONATHAN G				
ART UNIT 3623		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/042,899

Applicant(s)

BRITT ET AL.

Examiner

JONATHAN G. STERRETT

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a **Non-Final Office Action** in response to the communication received on 29 September 2008. **Claims 1-9** are pending, **Claims 16-20** are withdrawn.

Response to Arguments

2. Applicant's arguments have been fully considered but are moot in view of new grounds of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-9 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. **Claim 1** recites information that is received from wireless users where this information is used to "automatically select" a group of users based on information that is provided. This recitation is a nominal one and is not tied to a particular apparatus, thus the claim is not statutory.

Thus, **Claims 2-9** are non-statutory since they depend on Claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hendrickson et al.** (U.S. 6,754,470) in view of **Mayer** US 2005/0086211 (hereinafter **Hendrickson** and **Mayer**, respectively).

The examiner notes that there is significant overlap in the teachings of Mayer and Hendrickson. Although the examiner has set forth one way below where the claimed limitations are shown to be obvious, the examiner notes that, using the two references cited, there are other ways the references could be combined with a predictable result to render the claimed invention obvious.

As per claim 1, Hendrickson et al. discloses a method comprising:

sending a request for a return signal into a wireless network to a plurality of users of said wireless network having data processing devices (col. 7, lines 29-33, 53-57 and 64-67; col. 8, lines 12-15; A wireless network monitors wireless activity from (therefore, requests and receives signals from) devices of wireless users.);

receiving from said wireless network respective return signals from each of said plurality of users, each of said return signals containing information

describing its respective user (col. 8, lines 12-30; User data is received via the wireless network.);

receiving from said wireless network an inquiry, said inquiry having predetermined responses associated therewith, and receiving from said wireless network an attribute as a criteria for identifying recipients of said inquiry (col. 11, lines 36-40; col. 15, lines 8-16; col. 16, lines 15-16; A questionnaire may be invoked to prompt responses from wireless users. Also, emails may be exchanged among wireless panel members. It is known in the art that an email may be generated by one user and distributed to multiple users. See also col. 7, lines 12-24, where panel members may be selected/identified based on a number of criteria. See also col. 7, lines 1-11, where data gathering software invokes an "inquiry" into the events/activities of mobile device users with predetermined responses such as applications and features used as well as location of the mobile device when such applications/features are in use.);

Hendrickson teaches the gathering of marketing information related to wireless users (ie. demographic or other marketing related information). However, Hendrickson is concerned with gathering information (i.e. attributes) from users, rather than having a user select an attribute, which is then used in getting users to respond to that attribute, such that the response is forwarded back to the original user. Thus Hendrickson does not teach, but Mayer teaches:

Where the inquiry is generated by a first user

Para 16.

automatically selecting a group of users from said plurality of users, each user of said group of users having said attribute, said selecting including analyzing said respective information of each of said plurality of users, said attribute being identifiable from said respective information of each of said selected group of users and forwarding said inquiry into said wireless network to said group of users

para 11-15, based on the questionnaire filled out by the user (including certain attributes) this questionnaire is then forwarded to other users who meet the criteria, i.e. being automatically determined, since Mayer's invention is matching up potential dates based on the criteria input by a user.

receiving from said wireless network responses from one or more users in said group of users and forwarding said responses into said network to said first user

para 15, base on the identified matches to the questionnaire, this information is then forwarded back to the first user (i.e. by way of putting the contactees on the instant messaging list). See also para 45 – a two way match suggests those users identified need to reply such that their information is forwarded only when their criteria matches the original user's criteria. (see also para 73).

Henrickson and Mayer both address the use of wireless devices (e.g. pda's, cell phones) in communication, thus both Hendrickson and Mayer are analogous art. Further

they both address gathering information from users so that the intrinsic needs of users can be fulfilled.

One of ordinary skill in the art at the time of the invention would have modified the teachings of Hendrickson, regarding obtain various attributes of wireless device users for the purpose of filling their needs, to include the social networking and matchmaking teachings of Mayer to provide a predictable result, since Mayer teaches that individual data (e.g. sex, age) is useful as attributes in providing a wireless device matchmaking service. Thus the claimed limitations are a combination of elements known in the art that would be combinable to achieve a predictable result.

As per claim 2, Hendrickson et al. discloses the method as in claim 1 wherein said attribute is a specific geographical location (col. 11, lines 45-53).

As per claim 3, Hendrickson et al. discloses the method as in claim 1 wherein said attribute is a specific distance from said first user (col. 7, lines 1-11).

As per claim 4, Hendrickson et al. discloses the method as in claim 1 wherein said attribute includes a specific age (col. 11, lines 34-44).

As per claim 5, Hendrickson et al. discloses the method as in claim 1 wherein said attribute is a specific occupation (col. 11, lines 34-44).

As per claim 6, Hendrickson et al. discloses the method as in claim 1 wherein said attribute is a specific sex (col. 11, lines 34-44).

As per claim 7, Hendrickson et al. discloses the method as in claim 1 wherein said information includes a home address of its respective user (col. 11, lines 34-44).

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrickson et al. (U.S. 6,754,470) in view of Mayer, as applied above, and further in view of De Vries (U.S. 6,968,179).

As per claim 8, Hendrickson et al. does not expressly disclose receiving from said wireless network a signal from said first user, said signal identifying users of said wireless network who are on said first user's buddy list; adding to said respective information of each of those of said plurality of users who are on said first user's buddy list that he/she has been included in said first user's buddy list.

De Vries discloses receiving from said wireless network a signal from said first user, said signal identifying users of said wireless network who are on said first user's buddy list (col. 5, line 67-col. 6, line 3);

adding to said respective information of each of those of said plurality of users who are on said first user's buddy list that he/she has been included in said first user's

buddy list (col. 7, lines 33-43; Users may be grouped/added into different buddy lists based on different attributes.).

Hendrickson et al. and De Vries are analogous in that each facilitates communication via a wireless network and tracks certain wireless activities of users. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hendrickson et al. to add users to a user's buddy list because doing so enables users to communicate with and track certain wireless activities of a specifically defined group of users they're interested in, thereby enhancing the wireless activities tracking features of the system.

As per claim 9, Hendrickson et al. does not expressly disclose receiving from said wireless network a signal from said first user, said signal identifying users of said wireless network who are listed in said first user's address book; adding to said respective information of each of those of said plurality of users who are listed in said first user's address book that he/she has been included in said first user's address book.

De Vries discloses receiving from said wireless network a signal from said first user, said signal identifying users of said wireless network who are listed in said first user's address book (col. 5, line 67-col. 6, line 3);

adding to said respective information of each of those of said plurality of users who are listed in said first user's address book that he/she has been included in said

first user's address book (col. 7, lines 33-43; Users may be grouped/added into different buddy lists based on different attributes.).

Hendrickson et al. and De Vries are analogous in that each facilitates communication via a wireless network and tracks certain wireless activities of users. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hendrickson et al. to add users to a user's address book because doing so enables users to communicate with and track certain wireless activities of a specifically defined group of users they're interested in, thereby enhancing the wireless activities tracking features of the system.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached Monday – Friday from 10-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell, can be reached at 571-272-6737.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12-29-08

/JGS/

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623